IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Ned HOFFMAN

Serial No.:   09/441,107   Art Unit: 3627

Filed: November 16, 1999   Examiner: Joseph A. FISCHETTI

Confirm No.:   3861

For: SYSTEM AND METHOD FOR TOKENLESS BIOMETRIC
            ELECTRONIC SCRIP

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

This review is requested for the reason(s) states on the attached sheet(s). Note: no more than five (5) pages may be provided.
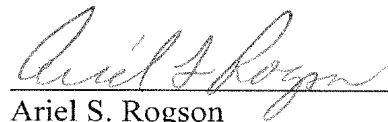
I am the:

☒   attorney or agent of record.

Total of _2_ forms are submitted.

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Respectfully submitted,
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ARGUMENTS IN SUPPORT OF PRE-APPEAL BRIEF CONFERENCE

Throughout the following remarks and arguments, the term "Office Action" refers to the Office Action dated May 15, 2006, and the term "Final Office Action" refers to the Final Office Action dated October 27, 2006. The term "Response" refers to the applicant's Response to the Office Action.

Merjanian does not teach a scrip supporter, scrip donator, and scrip beneficiary, and Medicaid does not operate with electronic scrip

In the Office Action, the Examiner first rejected the claims under 35 U.S.C. § 103(a) as being unpatentable over Merjanian. The Examiner asserted that Merjanian discloses a scrip supporter and a scrip donator, as well as the remaining limitations of claims 1, 16, 22, and 47. The Examiner was silent about a scrip beneficiary. In rejecting the claims, the Examiner cited the example of a user of food stamps or health account credits as inherently using electronic scrip, suggesting that terms such as "donator" and "supporter" are "met by the Medicaid embodiment of Merjanian without recitation of contrary definitions in the claims" (*see* Office Action, page 4).

The applicant responded by pointing out that Merjanian does not teach a scrip supporter, scrip donator, and scrip beneficiary. In fact, the reference is completely silent about scrip, and does not even suggest such a concept. Merjanian certainly does not teach all three concepts. For the same reason, the example of a person seeking benefits under programs such as welfare or Medicaid, as described in column 11 of Merjanian, fails to teach or make obvious the features of the claimed invention.

The applicant respectfully pointed out that the Examiner has not suggested that Merjanian teaches the concept of a "scrip beneficiary", which is a concept that is distinct from the "scrip donator" and "scrip supporter" terms.

In the Final Office Action, the Examiner explained why he thought Merjanian taught the features of the claims (scrip supporter, scrip donator, and scrip beneficiary). Specifically, the Examiner asserted, on the top of page 6 of the Final Office Action, that Merjanian discloses all participants of the Medicaid embodiment as follows;

> the scrip supporter is the patient who uses a Medicaid benefit,
> the scrip donator is the Medicaid agency, and
> the scrip beneficiary is the health care provider rendering the service.

But this accounting requires the "beneficiary" to be the health care provider, a concept that is contrary and backward from the idea that scrip transactions benefit and support the beneficiary. In fact, in a Medicaid transaction, the person who is benefiting from the transaction is the patient: the party the Examiner analogized to the "scrip supporter". In other words, the Examiner is attempting to read the scrip limitations into Merjanian's Medicaid embodiment, resulting in a failed analogy that demonstrates shortcomings of this reference to anticipate or make obvious the applicant's claims. The applicant discusses these shortcomings of Merjanian more fully in the Response, page 5, for example.

Merjanian does not teach or suggest a tokenless system

In the Office Action, the Examiner argued that Merjanian teaches a tokenless system, and referd to column 11 of Merjanian as disclosing a system that does not involve a smart card, and therefore is "tokenless". The applicant responded by pointing out that column 10, lines 19-22, where Merjanian discusses food stamps, actually teaches away from a tokenless system. Merjanian says that "[t]he card reader can be replaced by other data extracting means, such as a scanning wand, for extracting information from . . . food stamps". In other words, the food stamps have to be paper coupons or other physical objects that can be read by the "data extracting means", such as a scanning wand, a card reader, or the like. Because the food stamps have to be physical objects in Merjanian, and because they have to be presented at the point-of-sale to be read by the data extracting means, food stamps as intended by Merjanian are tokens. In contrast, the claimed invention is directed toward a tokenless method, namely where the transaction is performed without presenting tokens. Since Merjanian requires the presentation of a token, Merjanian cannot teach or suggest the claimed invention.

In the Office Action, the Examiner also cited column 11, lines 1-21 as teaching a tokenless operation. In the Response, page 6, last paragraph, the applicant noted that this section describes a user's enrollment with the system, and not a user's attempt to perform a transaction. The applicant also noted that throughout column 10, Merjanian describes performing transactions at a point of purchase terminal where a token – the food stamp – is presented. So this section of Merjanian also fails to teach or suggest the claimed invention.

In the Final Office Action, the Examiner asserted that Merjanian's Medicaid embodiment is tokenless (page 5, bottom), but ignored the applicant's arguments above. In addition, this embodiment describes acquiring fingerprint data during identification, which falls short of teaching or making obvious a tokenless system. One skilled in the art would not

be motivated to consider a tokenless system, especially in view of Merjanian's numerous embodiments that explicitly teach, as described above and in the Response, page 6, second paragraph, the use of tokens.

Further, the applicant believes that the Examiner has continued to erroneously consider Merjanian as teaching or making obvious a tokenless authorization of an electronic scrip transaction. Merjanian lacks a teaching of an electronic scrip transaction for at least the reason that Merjanian does not mention or suggest scrip. Merjanian also fails to make obvious an electronic scrip transaction for at least the reason that Merjanian lacks a motivation to perform an electronic scrip transaction. One skilled in the art would not be motivated to modify Merjanian to perform a scrip transaction.

Himmelstein does not teach the use of a personal identification code associated with biometrics to secure authentication

In the Office Action, the Examiner rejected claims 4, 46, and 48 under 35 U.S.C. § 103(a) using Merjanian in view of Himmelstein. The Examiner continued this rejection in the Final Office Action, noting that Himmelstein is cited for the purpose of using both an ID and a biometric to secure authentication in a transaction (page 6, second paragraph).

But, as the applicant argued in the Response, Himmelstein does not teach associating the biometrics with a personal identification code, as in claims 4, 46, and 48. For example, in the system of Himmelstein, it would be possible for one user to have the transponder, and another user to provide the voice command. The system would recognize that both conditions are met to execute the function, but there is no association between the identification code of the transponder and the templates in the memory of the system. Similarly, Merjanian does not teach or suggest any such association. Thus neither Merjanian nor Himmelstein teaches or suggests an association between a personal identification code and biometrics. The applicant explains this in detail in the Response, page 8.

The Examiner has not responded to these arguments.

Himmelstein teaches away from the proposed combination with Merjanian

Even if Merjanian could be considered a tokenless system (which, as argued above, the applicant disputes), Himmelstein teaches away from the proposed combination with Merjanian, because, as the applicant discussed in the Response, page 7, Himmelstein requires the use of a transponder, which is a token.

The Examiner appeared to agree that Himmelstein does not teach a tokenless system on page 6 of the Final Office Action. And if Merjanian is not tokenless, as argued above, then the combination of Merjanian and Himmelstein fails to teach or suggest a tokeneless system.
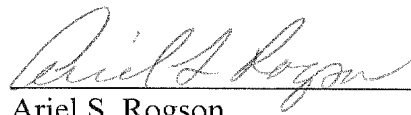
The Examiner, in the Final Office Action, explained that both references are concerned with protecting the assets of the user. But the applicant countered that asset protection is a very broad field spanning a variety of unrelated topics. For example, tokenless scrip transaction protection (to which the claims are directed) is an unrelated topic to that of token-based motor vehicle protection (Himmelstein). Thus, there is no motivation to combine Merjanian and Himmelstein. Further to this point, the applicant explained in the Response, page 7, first paragraph, that neither Merjanian nor Himmelstein teach any features other than those the Examiner asserts they respectively teach.

In conclusion, the applicant respectfully requests that the Examiner consider the claims' scrip limitations to be defined properly within the scope of scrip as known to one skilled in the art and as defined in the applicant's Specification.

The Applicant also asserts all arguments made previously, whether or not explicitly discussed herein, to preserve the right to assert these arguments in the Appeal Brief.

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